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AUG 22 2006

OFFICE OF PETITIONS

Decision on Petition

In re Application of Manaras et al. :
Application No. 08/272,002 :
Filing Date: July 8, 1994 :
Attorney Docket No. 10459-9"US" MJS/sm :

This is a decision on the petition filed September 19, 2005, under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application.

The petition is **dismissed**.

Facts:

A Notice of Allowance and a Notice of Allowability were mailed January 2, 1997.

The Notice of Allowance required payment of \$645 for the issue fee. The issue fee, a certified copy of a foreign patent, and an amendment under 37 CFR 1.312 were timely filed April 2, 1997.

The Notice of Allowability required submission of a substitute oath or declaration. The Notice of Allowance set a non-extendable statutory period for reply of three (3) months. An extension of time to reply to the Notice of Allowability was not obtained. A substitute oath or declaration was not filed on or before April 2, 1997. Therefore, the application became abandoned as of midnight on April 2, 1997.

A substitute declaration was filed *July 22, 1997*.

On January 23, 1998, the Office mailed a Notice stating the amendment under 37 CFR 1.312, filed prior to the abandonment of the application, would be entered as part of the application.

Petitioner filed a status inquiry letter on August 14, 1998. The status letter was received in the Office of Publications on August 21, 1998.

The Office mailed a Notice of Abandonment on September 24, 1998. The Notice stated the application was abandoned because the issue fee had not been received. However, the application was actually abandoned due to the failure to timely reply to the Notice of Allowability.

Petitioner has provided evidence indicating a status inquiry was sent electronically to the PTO at 703-305-8755 on December 8, 1999. The December 8, 1999 status inquiry is not in the file.

Petitioner filed a letter on December 16, 1999, requesting the status of the issuance of the patent and providing proof the issue fee, a certified copy of a foreign patent, and an amendment were timely filed April 2, 1997. The letter did not refer to the Notice of Abandonment. The letter was forwarded to the Office of Publications and received at that location on December 21, 1999.

Petitioner has provided evidence indicating a status inquiry was sent electronically to the PTO at 703-305-8755 on July 19, 2000. The July 19, 2000 status inquiry is not in the file.

Petitioner has provided evidence proving a status inquiry was filed with the Office on August 15, 2000.

The five year interval between the last status inquiry and the instant petition resulted from the patent agent responsible for the application leaving the law firm, reminders not being generated since no due dates had been docketed, the current assignee not being aware of the subject patent application until recently, and apparently the prior assignee not following up on the matter.

The instant petition requests:

- (1) withdrawal of the holding of abandonment,
- (2) entry of the amendment filed under 37 CFR 1.312 on April 2, 1997, and
- (3) issuance of the patent.

Discussion:

As a result of the error regarding the cause of abandonment listed on the Notice of Abandonment, the petition does not discuss the failure to timely reply to the Notice of Allowability. The Office has no information to indicate the substitute declaration was timely filed. The Office notes the signature on the cover letter accompanying the substitute declaration is dated July 21, 1997.

For the reasons above, the Office is unable to withdraw the holding of abandonment and send the application to be issued as a patent.

The Office notes that Office records indicate the amendment under 37 CFR 1.312 has been entered.

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (the substitute declaration already submitted), the required petition fee (\$750 for a small entity), a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and a terminal disclaimer. A PDF fillable version of a 37 CFR 1.137(b) form and terminal disclaimer forms can be found at <http://www.uspto.gov/web/forms/index.html>.

The terminal disclaimer:

37 CFR 1.137(d) requires a petition to revive for a utility application filed before June 8, 1995, to be accompanied by a terminal disclaimer dedicating a terminal part of the term granted equivalent to the lesser of:

- (1) the period of abandonment, or
- (2) the period beyond the date 20 years after the filing date of the application.

Example: Assume a petition to revive was granted 04/02/07 and a patent issued 09/02/07, the terminal disclaimer would have to disclaim 120 months resulting in the patent expiring on 09/02/14.

As an alternative to completing the PTO terminal disclaimer form labeled SB/63 found at the link on the prior page, petitioner may wish to consider filing a petition under 37 CFR 1.183 and the terminal disclaimer form labeled SB/62 found on at the same link.

Form SB/62 allows an applicant to specifically designate a number of months to be disclaimed. The Office will accept a designation of 84 months if the terminal disclaimer is accompanied by a grantable petition to revive and a petition under 37 CFR 1.183 to partially waive the requirements of 37 CFR 1.137(d).

The terminal disclaimer should include a showing in compliance with 37 CFR 3.73(b). The terminal disclaimer should be signed by a party authorized to act on behalf of the assignee or signed by an attorney/agent of record.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are NOT permitted.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
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Telephone inquiries regarding this communication should be directed to Petitions Attorney
Shirene Brantley at (571) 272-3230.

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